

REMARKS

This Amendment is submitted in response to the Office Action dated 24 May 2005, the time to respond being until 24 August, 2005. Reconsideration and allowance of this application are respectfully requested. Claims 7 and 12 are canceled. Although the Examiner states that all of Claims 4-12 are withdrawn from further consideration as they are drawn to non-elected species, Applicants respectfully disagree as to claims 4-6 and 8-11 and offer their arguments in support of their position below. Applicant believes that claims 1 through 6 and 8 through 11 should remain pending in the application.

The Examiner noted an informality in the omission of reference numeral 2.53 in the description for Fig. 3. Reference numeral 2.53 equates to reference numeral 1.53, which is described on page 11, line 16 as “concealed holder information”. To further clarify this point, the specification is herein amended at the paragraph that begins at page 14, line 8 to add:

“...Note that the decimal reference numerals in FIG. 3 are intended by their prefix “2” to denote the second embodiment, the suffix to denote part number, and like suffixes used in FIGs. 2 and 3 denote like components...” and *“...The desired side of the indicia 2.40 selected from an indicia source is placed under two die cut tabs 2.58 cut into holder 2.50, revealing the displayed indicia information 2.43 and displayed holder information 2.57, yet covering concealed holder information 2.53.”* Owing to this change in the text a Drawing Change is not considered necessary.

Species Election:

Applicant respectfully requests reconsideration of the Examiner’s decision to withdraw claims 4-12 from further consideration. Applicant previously elected Species II, the embodiment

illustrated in Fig 3. The Examiner states that all of claims 4 through 12 include features that are unique to embodiments other than the one illustrated in Fig. 3, and therefore these claims do not read on the elected embodiment and are thus withdrawn. Applicant respectfully disagrees as to claims 4-6 and 8-11.

Fig. 2 originally represented the preferred embodiment and as such the claims were recited to reflect the preferred embodiment. As Fig.3 is the elected species, several of the claims must be amended to delete the preferred embodiment matter.

Regarding Claim 4, the elected species as described in Fig. 3, shows a holder unit 2.50 comprising a rigid material [see page 11, line 5 and amended page 14, line 8] with a concealed holder field 2.52 [see page 11, line 6] and a displayed holder field 2.55 [see page 11, line 8]. Claim 4 is herein amended to remove the reference to folding, i.e., to : “*An information organization and display product according to claim 2, wherein said holder unit comprises a rigid material, with a concealed holder field and a displayed holder field.*

Claim 5 is amended herein to remove the reference to both sides. Thus, regarding amended Claim 5, the elected species as described in Fig. 3, shows “An information organization and display product according to claim 2, wherein said display unit comprises two sheets of flexible, clear plastic material [see page 11, line 20], with front sheet and rear sheet permanently bonded at first side edge, bottom edge, and second side edge [see page 14, line 15] forming a pocket for insertion of indicia and display; wherein top edge of front sheet and top edge of back sheet are not bonded and a plurality of flap tabs 2.30 are permanently attached to the unbonded edges, said flap tabs are flexibly attached to the top edge of the display pocket and comprise a seam separating the front and distal portions of said tabs with *a releasable adhesive applied to distal portions of said flap tabs* [see page 15, line 3].”

Claim 6 is amended herein to remove the reference to bonding at three sides. Thus, regarding amended Claim 6, the elected species as described in Fig. 3, shows: "An information organization and display product according to claim 2, wherein said display unit comprises two sheets of flexible, clear plastic material [page 7, line 10, page 11, line 20; ref. 2.20], with front sheet and rear sheet permanently bonded at bottom edge and second side edge, and top edge and first side edge is open, forming a pocket for insertion of indicia and display; wherein top edge and first side edge of front sheet and top edge and second side edge of back sheet are not bonded and a plurality of holes are punched on the unbonded edges of second side, and said first side contains a plurality of embossed index tabs along the edge. [page 14, line 15-19]."

Claim 8 is amended herein to remove the reference to unbonding on one side. Thus, regarding amended Claim 8, the elected species as described in Fig. 3, shows: "An information organization and display product, comprising:

an indicia 2.40 selected from an indicia source;

a holder unit 2.50 selected from a holder source;

and a display unit 2.20 made from clear plastic material [page 7, line 10, page 11, line 20; ref. 2.20], having a pocket portion, unbonded on *at least* one side and one or more tab portions, selected from a display source, whereby the indicia is placed in a suggested manner against the holder unit and the indicia and holder unit are inserted into the display unit, such that the indicia is displayed [page 14, lines 15-17]."

Claim 9 is amended herein to remove the reference to the means of separation. Thus, regarding amended Claim 9, the elected species as described in Fig. 3, shows: "An information organization and display product according to claim 8, wherein said indicia comprises two

concealed indicia fields adjacent to the top and bottom edges of indicia, such concealed indicia fields are separated from displayed indicia fields.” [See page 14, lines 11-12.]

Claim 10 is amended herein to remove the reference to the fold. Thus, regarding amended Claim 10, the elected species as described in Fig. 3, shows: “An information organization and display product according to claim 8, wherein said holder unit comprises a rigid material, with two die cut tabs cut into the holder. [See page 14, lines 12-13.]”

Regarding Claim 11, the elected species as described in Fig. 3, shows: “An information organization and display product according to claim 8, wherein said display unit comprises two sheets of flexible, clear plastic material [page 7, line 10, page 11, line 20; ref. 2.20], with front sheet and rear sheet permanently bonded at first side edge and bottom edge, leaving second side edge and top edge open for receiving the combined indicia and holder [page 14, lines 15-17]; wherein top edge of front sheet and top edge of back sheet are not bonded and a plurality of index tabs are permanently attached to the first side edges [page 14, line 20 through page 15, line 3].”

Claim Objections:

The Examiner objected to informalities in Claim 1. Claim 1 is herein amended to correct the text.

Claim Rejections:

The Examiner rejected claims 2-3 under 35 U.S.C. 112, second paragraph, as being indefinite for failure to particularly point out and distinctly claim the subject matter. According to the Examiner, regarding Claim 2, the term “indexed” is not understood in this context. Claim

2 is herein amended to deleted the term “*indexed*”.

The Examiner is correct that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made.

The Examiner rejected Claim 1 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,301,919 to Morgan in view of U.S. Patent No. 5,667,248 to Mayer and U.S. Patent Application No. 2003/0211268 to Hillemann et al. According to the Examiner, Morgan ‘919 discloses a method substantially as claimed¹, with the exception of hidden indicia on either the flexible indicia or the rigid holder and a flap tab portion with reusable adhesive attached thereto. The Examiner concludes that it is well known to provide hidden instructional indicia and Mayer ‘248 shows an example of such indicia, and that it would have been obvious to one skilled in the art to include hidden instructional indicia to either or both of the indicia and/or holder, as taught by Mayer, to instruct the user in the proper use of the invention. The Examiner further avers that Hillemann et al. teaches that it was known to provide a transparent display with a flap having a reusable adhesive to protect the contents of the display by releasably sealing them inside the display, and that it would have been obvious to one skilled in the art to provide the display as disclosed with a flap having an adhesive portion to protect the contents of the display by releasably sealing them inside the display. Applicant respectfully disagrees with the Examiner and maintains that the claims are patently distinguishable from Morgan ‘919, Mayer ‘248 and Hillemann et al.

The Morgan ‘919 patent very narrowly discloses a kit for returning lost or stolen wallets

¹ Comprising the steps of selecting one or more flexible indicia from an indicia source, selecting one or more substantially rigid holders from a holder source, each of the holders having holder information to be displayed; applying one or more of the indicia to each of the holders, to form a combined indicia and holder; selecting a display from a display source for each of the holders selected, wherein the display comprises a pocket portion, inserting the

and like articles, which uses a card, a postage stamp, a mailing label, adhesive tape [col.1, line 37], and a transparent holder [col. 1, line 47]. The goal of the Morgan patent is to provide a means to allow someone who finds a lost wallet to easily return it to the owner. There are two major components, 1) a card with instructional indicia, removable indicia, i.e., a stamp and mailing label affixed to the card and tape for attaching a wallet; and 2) a transparent folder or sleeve for inserting the card. The purpose of the sleeve is to keep the card rigid and protect the kit by preventing the label and stamp from loosening. [See col. 2, lines 26-28.] In contrast, the present invention teaches three very distinct major components, 1) any indicia from any indicia source, 2) any substantially rigid holder from any holder source, and 3) any display from any display source. The indicia are informational in nature, such as a recipe, newspaper article, printout, etc., unlike the removable stamp and mailing label of Morgan '919. The display shows the holder and indicia from either side such that the holder and indicia may be read from each side and, protects the holder and indicia, and permits the application of the display to a surface or to be inserted into a binder, unlike the sleeve of Morgan '919, which is meant to help to hold the stamp and label in place. Morgan '919 does not teach the method for storing, organizing, indexing, retrieval, and display of the present invention, including selecting any indicia from any indicia source, selecting any substantially rigid holder from any holder source, with the holder having displayed and concealed information, and selecting any display from any display source, nor the information organization and display product that includes any indicia from any indicia source, any substantially rigid holder from any holder source, with the holder having displayed and concealed information, and any display from any display source.

Moreover, Claim 1 is further distinguished as Morgan teaches a mail return kit comprising a card, a postage stamp, a mailing label, adhesive tape and a transparent folder and is not analogous art. Analogous Art is that which is “reasonably pertinent to the particular problem with which the inventor is involved.” Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc., 21 F.3d 1068, 1072; 30 USPQ2d 1377, 1379 (Fed. Cir. 1994). The goal of the present invention (organizing information for storage and display) has nothing to do with a mail return kit, which is simply not pertinent.

The Examiner combines Mayer ‘248 and contends that Mayer teaches hidden instructional indicia and it would have been obvious to modify the invention of Morgan to include the hidden instructional indicia of Mayer. The present invention teaches a method and product for storage, organization, indexing, retrieval, and display of information. Mayer, on the other hand, teaches a greeting card with detachable covers for delivering a multipart message on a single page, as an alternate to the conventional two page greeting card. Contrary to the Examiner’s assertion, Mayer does not teach hidden instructional indicia for instructing the user in the proper use of the invention, but instead teaches a two-part greeting card message for entertaining or otherwise conveying a special occasion greeting card message. As with Morgan, Mayer is not analogous art. Heidelberger, Id. The goal of the present invention (organizing information for storage and display) has nothing to do with an alternate greeting card that delivers a two-part message, and Mayer is simply not pertinent.

Obviousness can only be established by showing that “there must have been a reason, suggestion, or motivation to lead an inventor to combine [the] prior art references.” Pro-Mold and Tool Co. v. Great Lakes Plastics, Inc., 75 F.3d 1568, 1572-73 (Fed. Cir. 1996). The suggestion to do so may come expressly from the references themselves, implicitly from the

prior art where the technology is relatively straightforward, from the knowledge of those skilled in the art, or from the nature of the problem to be solved. See Id.; Cable Elec. Prods., Inc. v. Genmark, Inc., 770 F.2d 1015, 1025 (Fed. Cir. 1985), (overruled on other grounds by Midwest Indus., Inc. v. Karavan Trailers, Inc., 175 F.3d 1356 (Fed. Cir. 1999)); Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed.Cir. 1997). Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement is obvious.” In re Rothermel, 47 CCPA 866, 870; 276 F.2d 393, 396; 125 USPQ 328, 331 (1960). The invention of Claim 1 was not obvious at the time it was made, particularly in light of Morgan’s mail return kit comprising a removable stamp and label for affixing to a returned wallet and Mayer’s greeting card with detachable covers for delivering a multipart message on a single page. Applicant maintains that there is no teaching, suggestion, or motivation at all to combine the teachings of Morgan and Mayer as their design goals and methods are so divergent. Consequently, Claim 1 is patently distinguished.

The Examiner combines U.S. Patent Application No. 2003/0211268 by Hillemann et al. and contends that Hillemann et al. teaches a transparent display with a flap having a reusable adhesive to protect the contents of the display by releasably sealing them inside the display and it would have been obvious to modify the invention of Morgan to include the transparent display with a flap having a reusable adhesive to protect the contents of the display by releasably sealing them inside the display. The present invention teaches a method and product for storage, organization, indexing, retrieval, and display of information. Hillemann, et al., on the other hand, teaches a resealable plastic packing slip envelope. The closure flap solely functions to close the envelope, and not to attach the envelope to a surface if desired. As with Morgan and

Mayer, Hillemann, et al. is not analogous art. The goal of the present invention (organizing information for storage and display) has nothing to do with a packing slip envelope, which is simply not pertinent.

Moreover, as with Morgan and Mayer, the invention of Claim 1 was not obvious at the time it was made, particularly in light of Morgan's mail return kit comprising a removable stamp and label for affixing to a returned wallet and Hillemann et al.'s packing slip envelope. Applicant maintains that there is no teaching, suggestion, or motivation at all to combine the teachings of Morgan and Hillemann, et al. as their design goals and methods are so divergent. Consequently, Claim 1 is patently distinguished.

The Examiner rejected Claim 2 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 4,301,919 to Morgan in view of U.S. Patent Application No. 2003/0211268 to Hillemann et al. According to the Examiner, Morgan '919 discloses an invention substantially as claimed (i.e., comprising an indicia, a holder unit, and a display unit having a pocket portion), with the exception of a tab portion, that Hillemann et al. teaches that it was known to provide a transparent display with a flap having a reusable adhesive to protect the contents of the display by releasably sealing them inside the display, and that it would have been obvious to one skilled in the art to provide the display disclosed with a flap having an adhesive portion to protect the contents of the display be releasably sealing them inside the display. Applicant respectfully disagrees with the Examiner inasmuch as the claims are patently distinguishable from Morgan '919 and Hillemann et al. on the same bases as claim 1. As stated above, the Morgan '919 patent very narrowly discloses a kit for returning lost or stolen wallets and like articles, which uses a card, a postage stamp, a mailing label, adhesive tape, and a transparent holder. The goal of the Morgan patent is to provide a means to allow someone who finds a lost wallet to easily return it

to the owner. There are two major components, 1) a card with instructional indicia, removable indicia, i.e., a stamp and mailing label affixed to the card and tape for attaching a wallet; and 2) a transparent folder or sleeve for inserting the card. The purpose of the sleeve is to keep the card rigid and protect the kit by preventing the label and stamp from loosening. In contrast, the present invention teaches three very distinct major components, 1) any indicia from any indicia source, 2) any substantially rigid holder from any holder source, and 3) any display from any display source. The indicia are informational in nature, such as a recipe, newspaper article, printout, etc., unlike the removable stamp and mailing label of Morgan '919. The display shows the holder and indicia from either side such that the holder and indicia may be read from each side and, protects the holder and indicia, and permits the application of the display to a surface or to be inserted into a binder, unlike the sleeve of Morgan '919, which is meant to help to hold the stamp and label in place. Morgan '919 does not teach any indicia selected from any indicia source, any holder unit selected from any holder source and any display unit from any display source. Moreover, Claim as in Claim 1, Claim 2 is further distinguished as Morgan teaches a mail return kit comprising a card, a postage stamp, a mailing label, adhesive tape and a transparent folder and is not analogous art.

The Examiner combines U.S. Patent Application No. 2003/0211268 by Hillemann et al. and contends that Hillemann et al. teaches a transparent display with a flap having a reusable adhesive to protect the contents of the display by releasably sealing them inside the display and it would have been obvious to modify the invention of Morgan to include the transparent display with a flap having a reusable adhesive to protect the contents of the display by releasably sealing them inside the display. The present invention teaches an information organization and display product. Hillemann, et al., on the other hand, teaches a resealable plastic packing slip

envelope. The closure flap solely functions to close the envelope, and not to attach the envelope to a surface if desired. As with Morgan and Mayer, Hillemann, et al. is not analogous art. The goal of the present invention (organizing information for storage and display) has nothing to do with a packing slip envelope, which is simply not pertinent. Applicant maintains that there is no teaching, suggestion, or motivation at all to combine the teachings of Morgan and Hillemann, et al. as their design goals and methods are so divergent. Consequently, Claim 2 is patently distinguished.

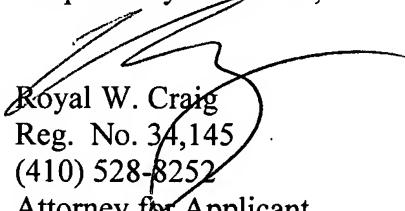
Claim 3 is herein amended to clarify that the displayed indicia field and the concealed indicia field are two separate and distinct fields. Amended Claim 3 recites: “An information organization and display product according to claim 2, wherein said indicia comprises *two distinct fields, ...*” Patent novelty is no principally predicated on mere printed matter and arrangements thereof as stated by the Examiner, because amended Claim 3 is depending from Claim 2, include the same above-described limitations, and are thus likewise patently distinguished.

With references that are entirely unconcerned with the goals of the present invention (i.e., the greeting card of Mayer and the packing slip envelope of Hillemann, et al., the Examiner has resorted to piecemeal combining of individual features of prior art and runs afoul of the basic mandate inherent in Section 103 – that piecemeal reconstruction shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870; 276 F.2d 393, 396; 125 USPQ 328, 331 (1960). “Improvement over prior art, even though it be simple or involves only a reversing of certain parts, is patentable unless prior art shows that improvement as obvious.” Id. The present invention is an information organization product and method and not a mail return kit, greeting card nor packing slip envelope.

Applicant respectfully declines to amend Claims 1 and 2 at this time because Applicant believes that with the above amendments and remarks, Independent Claims 1 and 2 are now in the proper condition for allowance, but Applicant reserves the right to amend Claims 1 and 2 should the Examiner maintain his rejection of these claims.

In view of the above amendments and remarks, it is believed that this application is now in the proper condition, and a Notice of Allowance is respectfully requested.

Respectfully submitted,



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